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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/563,026	12/30/2005	Owen Derek Barr	2111.001	6051
23598 7590 11/16/2009 BOYLE FREDRICKSON S.C. 840 North Plankinton Avenue MILWAUKEE, WI 53203				
EXAMINER				
CAJILIG, CHRISTINE T				
ART UNIT		PAPER NUMBER		
3633				
NOTIFICATION DATE		DELIVERY MODE		
11/16/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@boylefred.com

Office Action Summary

Application No.

10/563,026

Applicant(s)

BARR, OWEN DEREK

Examiner

CHRISTINE T. CAJILIG

Art Unit

3633

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-40, 42-49 and 52-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34-40, 42-49 and 52-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 8/07/09
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 8/07/09 was filed after the mailing date of the first office action on 1/26/09. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 34-37, 44, and 42-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shickel (U.S. Patent No. 4,784,891) in view of over in view of Naumovich, Jr. (U.S. 4,328,652).

Regarding claim 34, Shickel discloses a multi-layer covering comprising: a fabric layer (1) defining an outer surface of the multi-layer covering; a non-fabric backing layer (2), the backing layer being bonded to an inner surface of the fabric layer (via adhesive 19) and coextensive with the fabric layer; and wherein the fabric layer is sufficiently porous to allow the applied coating to penetrate to the backing layer and the backing layer has a series of through hole (30) adapted to allow the applied coating to penetrate through the backing layer to the object surface.

Shickel does not disclose an adhesive layer disposed on an inner surface of the backing layer and a removable protective layer covering the adhesive on the inner surface of the backing layer; wherein the protective layer is removable to allow the multi-layer covering to be adhered to and cover the object surface, such that the outer surface of the multi-layer covering provides a smooth outer surface for supporting the applied coating.

Naumovich, Jr. in Figure 4a discloses that insulation coverings (64, 68) comprise an adhesive (66) disposed on an inner surface of the backing layer (68); and a removable protective layer (70) covering the adhesive on the inner surface of the backing layer; removing the removable protective layer from the multi-layer covering; applying the multi-layer covering to the object surface using the adhesive layer to retain the multi-layer covering in position to facilitate installation.

It would have been obvious to a person skilled in the art to modify the covering of Shickel to have an adhesive with a removable liner attached to the backing layer and applying the multi-layered covering to the wall via the adhesive as taught by Naumovich, Jr. to facilitate installation.

Regarding claim 35, Shickel modified by Naumovich, Jr. further discloses that the holes in the backing layer comprise a grid of blister holes punched through the backing layer.

Regarding claim 36, Shickel modified by Naumovich, Jr. further discloses that the holes have a diameter of 0.5 mm to 10 mm and the holes are spaced apart by 10 mm to 300 mm (Col 4, Ln 3-11).

Regarding claim 37, Shickel modified by Naumovich, Jr. further discloses that the holes have a diameter of 0.6 mm to 5 mm, and the holes are spaced apart by of 10 mm to 50 mm (Col 4, Ln 3-11).

Regarding claims 42, 43, and 45, Shickel modified by Naumovich, Jr. does not disclose that the fabric is formed from a woven or non-woven fabric that has a thickness from 2 mm to 5 mm and the woven fabric is made from fibres or strands and wherein either gaps between fibres in the fabric are defined in the range of 0.3 mm to 3.0 mm or holes having a diameter of 0.3 mm to 3.0 mm are defined in the fabric.

It would have been obvious to one having ordinary skill in the art at the time of invention to use a woven or non-woven fabric having a spacing of 0.3 to 3.0 mm between strands and to be between 2mm to 5mm in thickness, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). Such a material would allow for more adhesion of subsequent coatings on the fabric layer and the thickness of such layer may be substantially reduced depending on the desired level of thermal resistance.

Regarding claims 44 and 46, Shickel modified by Naumovich, Jr. does not disclose that the fabric layer is a flexible mesh layer or is made of plastic that defines a spacing between strands of the mesh of 3 mm to 20 mm.

It would have been obvious to one having ordinary skill in the art at the time of invention to use a mesh material made with plastic having a spacing of 3-20mm between strands, since it has been held to be within the general skill of a worker in the

art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). Such a material would provide more adhesion of subsequent coatings on the mesh layer.

Regarding claim 47, Shickel modified by Naumovich, Jr. further discloses that the backing layer is a metallic reflective foil (24).

Regarding claim 48, Shickel modified by Naumovich, Jr. further discloses that the backing layer includes a metallic reflective foil (24) and building paper (26).

Regarding claim 49, Shickel modified by Naumovich, Jr. further discloses that the backing layer is a building paper (26).

Claim 52 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shickel modified by Naumovich, Jr. as applied to claim 34 above, and further in view of Beaupre (U.S. Patent No. 4,310,587).

Regarding claim 52, Shickel modified by Naumovich, Jr. further discloses that the backing layer includes metallic foil and a sheet of building paper, but does not disclose that the backing layer includes two metallic reflective foils sandwiching a sheet of building paper.

Beaupre discloses a building covering with a backing comprising a paper layer sandwiched between two metallic reflective foils (26, 28) to provide fire resistant backing.

It would have been obvious to a person having ordinary skill in the art at the time of the Applicant's invention to modify the structure of Shickel modified by Naumovich, Jr. to have the paper layer sandwiched between two metallic foils as taught by Beaupre to provide a fire resistant backing layer.

Claims 34-37, 44, 42-49, 53-56, and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fuhrer (U.S. Patent No. 4,841,705) in view of Naumovich, Jr. (U.S. 4,328,652) and Shickel (U.S. Patent No. 4,784,891).

Regarding claims 34 and 53, Fuhrer in Figures 1, 3, and 4 discloses a multi-layer covering and a method of treating an object surface such as a wall, ceiling, roof, or floor by comprising the steps of: providing a multi-layer covering, the multi-layer covering including: a porous fabric layer (16) defining an outer surface of the multi-layer covering; a non-fabric backing layer (28), the backing layer being bonded to an inner surface of the fabric layer (via adhesive 34) and coextensive with the fabric layer; applying the multi-layer covering to the object surface, so that substantially all of the object surface is covered by both the fabric layer and the backing layer and so that the outer surface of the multi-layer covering provides a smooth outer surface; and applying one or more coatings (18, 20) to the smooth outer surface of the multi-layer covering, such that the applied coating penetrates through the fabric layer (Col 7, Ln 45-53) and through the holes of the backing layer to the object surface.

Fuhrer does not disclose that the non-fabric backing layer (28) having a series of through holes; an adhesive disposed on an inner surface of the backing layer; and a

removable protective layer covering the adhesive on the inner surface of the backing layer; removing the removable protective layer from the multi-layer covering; applying the multi-layer covering to the object surface using the adhesive layer to retain the multi-layer covering in position.

Shickel discloses a multi-layered insulation backing comprising a series of through holes (30) for venting vapors.

Naumovich, Jr. in Figure 4a discloses that insulation coverings (64, 68) comprise an adhesive (66) disposed on an inner surface of the backing layer (68); and a removable protective layer (70) covering the adhesive on the inner surface of the backing layer; removing the removable protective layer from the multi-layer covering; applying the multi-layer covering to the object surface using the adhesive layer to retain the multi-layer covering in position to facilitate installation.

Both Fuhrer and Shickel teach that insulation is used to cover a surface of a building and it would have been obvious to one skilled in the art to substitute the insulation of Shickel for the other to achieve the predictable result of having a multi-layer insulation with apertures that allow for venting of vapors. Moreover, it would have been obvious to a person skilled in the art to modify the covering of Fuhrer modified by Shickel to have an adhesive with a removable liner attached to the backing layer and applying the multi-layered covering to the wall via the adhesive as taught by Naumovich, Jr. to facilitate installation. Per the modification, the applied coating would penetrate through the fabric layer and the holes of the backing.

Regarding claim 35, Fuhrer modified by Shickel and Naumovich, Jr. further discloses that the holes in the backing layer comprise a grid of blister holes punched through the backing layer.

Regarding claim 36, Fuhrer modified by Shickel and Naumovich, Jr. further discloses that the holes have a diameter of 0.5 mm to 10 mm and the holes are spaced apart by 10 mm to 300 mm (Col 4, Ln 3-11).

Regarding claim 37, Fuhrer modified by Shickel and Naumovich, Jr. further discloses that the holes have a diameter of 0.6 mm to 5 mm, and the holes are spaced apart by of 10 mm to 50 mm (Col 4, Ln 3-11).

Regarding claims 42, 43, and 45, Fuhrer modified by Shickel and Naumovich, Jr. does not disclose that the fabric is formed from a woven or non-woven fabric that has a thickness from 2 mm to 5 mm and the woven fabric is made from fibres or strands and wherein either gaps between fibres in the fabric are defined in the range of 0.3 mm to 3.0 mm or holes having a diameter of 0.3 mm to 3.0 mm are defined in the fabric.

It would have been obvious to one having ordinary skill in the art at the time of invention to use a woven or non-woven fabric having a spacing of 0.3 to 3.0 mm between strands and to be between 2mm to 5mm in thickness, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). Such a material would allow for more adhesion of subsequent coatings on the fabric layer and the thickness of such layer may be substantially reduced depending on the desired level of thermal resistance.

Regarding claim 44, Fuhrer modified by Shickel and Naumovich, Jr. does not disclose that the fabric layer is a flexible mesh layer that defines a spacing between strands of the mesh of 3 mm to 20 mm.

It would have been obvious to one having ordinary skill in the art at the time of invention to use a mesh material having a spacing of 3-20mm between strands, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). Such a material would provide more adhesion of subsequent coatings on the mesh layer.

Regarding claim 46, Fuhrer modified by Shickel and Naumovich, Jr. further discloses that the fabric layer is made from plastics material (Col 5, Ln 5-10).

Regarding claim 47, Fuhrer modified by Shickel and Naumovich, Jr. further discloses that the backing layer is a metallic reflective foil (24, per substitution by Shickel).

Regarding claim 48, Fuhrer modified by Shickel and Naumovich, Jr. further discloses that the backing layer includes a metallic reflective foil (24) and building paper (26).

Regarding claim 49, Fuhrer modified by Shickel and Naumovich, Jr. further discloses that the backing layer is a building paper (26).

Regarding claims 54 and 56, Fuhrer modified by Shickel and Naumovich, Jr. further discloses that the step of applying one or more coatings comprises applying one

or more coatings of acrylic render (Col 6, Ln 55-62) and wherein the render would inherently penetrate into the gaps between the fibres of the fabric or the holes in the backing layer to reach the object surface so that the covering is saturated with acrylic render or paint.

Regarding claim 55, Fuhrer modified by Shickel and Naumovich, Jr. further discloses that the multi-layered covering is applied to a wall and the coating is a render (Col 6, Ln 55-62).

Regarding claim 58, Fuhrer modified by Shickel and Naumovich, Jr. further discloses that the covering is applied to a floor and the coating is grout or adhesive (Col 9, Ln 44-53).

Claims 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fuhrer in view of Shickel and Naumovich, Jr. as applied to claim 34 above, and further in view of Maylon (U.S. Patent No. 5,697,195).

Regarding claim 38, Fuhrer modified by Shickel and Naumovich, Jr., further disclose that the fabric layer may instead be made of wire lath (Col 9, Ln 54-56) but does not expressly disclose that the wire laths have holes.

Maylon discloses a double layer backing to receive plaster wherein both the wire lath (22) and the backing (20) have holes.

It would have been obvious to a person having ordinary skill in the art at the time of the Applicant's invention to modify Fuhrer modified by Shickel and Naumovich, Jr. to

include a wire lath with openings as taught by Maylon to provide superb adherence for the coating applied.

Regarding claims 39 and 40, Fuhrer modified by Shickel, Naumovich, Jr., and Maylon does not disclose that the holes have a diameter of 0.6 mm to 5 mm, and the holes are spaced apart by of 10 mm to 50 mm.

It would have been obvious to one having ordinary skill in the art at the time of invention to use a holes with a diameter of 0.6 mm to 5 mm, and spaced apart by of 10 mm to 50 mm, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). Such a material would provide more adhesion of subsequent coatings on the mesh layer.

Claim 52 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fuhrer modified by Shickel and Naumovich, Jr. as applied to claim 34 above, and further in view of Beaupre (U.S. Patent No. 4,310,587).

Regarding claim 52, Fuhrer modified by Shickel and Naumovich, Jr. further discloses that the backing layer includes metallic foil and a sheet of building paper, but does not disclose that the backing layer includes two metallic reflective foils sandwiching a sheet of building paper.

Beaupre discloses a building covering with a backing comprising a paper layer sandwiched between two metallic reflective foils (26, 28) to provide fire resistant backing.

It would have been obvious to a person having ordinary skill in the art at the time of the Applicant's invention to modify the structure of Fuhrer modified by Shickel and Naumovich, Jr. to have the paper layer sandwiched between two metallic foils as taught by Beaupre to provide a fire resistant backing layer.

Claim 57 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fuhrer in view of Shickel and Naumovich, Jr. as applied to claim 53 above, and further in view of Curtis (U.S. Patent No. 3,466,222).

Regarding claim 57, Fuhrer modified by Shickel, and Naumovich, Jr., further disclose that the multi-layered covering may be used in applications other than wall covering systems such as floors, but does not disclose that the covering is applied to a roof and the coating is adhesive.

Curtis discloses using a multi-layered insulation coverings can be installed on a roof and coated with bituminous material (14) such as tar (Figure 1Col 6, Ln 3-9).

It would have been obvious to a person having ordinary skill in the art at the time of the applicant's invention to use the multi-layered covering of Fuhrer modified by Shickel and Naumovich, Jr. on a roof and covered with tar as taught by Curtis to provide a superb insulating cover for a building.

Response to Arguments

Applicant's arguments filed 6/22/09 have been fully considered but they are not persuasive.

In response to applicant's argument that the insulating multi-layered covering of Shickel is not intended to be used as a surface covering adapted to support an outer coating, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Gahwyler (CH 602968).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTINE T. CAJILIG whose telephone number is (571) 272-8143. The examiner can normally be reached on Monday-Thursday, 9 am - 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Canfield can be reached on (571) 272-6840. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. T. C./

Examiner, Art Unit 3633

/Robert J Canfield/

for R. Chilcot, SPE of Art Unit 3633/3635